

PATENT

Appl. No. 09/444,359
Arndt. Dated October 27, 2003
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 2684

REMARKS/ARGUMENTS

Claims 1-42 were pending in this application. No claims have been amended, added, or canceled. Hence, claims 1-42 remain pending. Reconsideration of the subject application as amended is respectfully requested.

General Remarks

The Applicants urge the Examiner to withdraw the finality of the previous office action and **FULLY** address the Applicants' previously-presented arguments. The Applicants respectfully call the Examiner's attention to 37 CFR §1.104(d)(2) and MPEP § 2140.01. Maintaining the rejections of the pending claims is **IMPROPER** unless the Examiner either: 1) cites a reference in the prior art for the motivation or suggestion to modify the references as suggested to make the Applicants' invention; or 2) provides an affidavit stating the facts within the personal knowledge of the Examiner for this teaching. These requirements **ARE NOT OPTIONAL**. The Applicants should not be expected to pay for yet another Request for Continued Examination to further argue these points. Counsel for the Applicants would welcome a phone call from the Examiner if the Examiner feels that further discussion would move the case toward allowance.

Claims 1-26, 30-34, 37-39, and 42, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent 6,230,017 to Andersson, *et al.* (hereinafter "Andersson"), and in view of the cited portions of U.S. Patent No. 6,148,197 to Bridges, *et al.* (hereinafter "Bridges").

Claims 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Andersson, in view of Bridges and further in view of the cited portions of U.S. Patent No. 6,397,040 to Titmuss, *et al.* (hereinafter "Titmus").

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Claims 28-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Andersson, in view of Bridges and further in view of the cited portions of U.S. Patent No. 6,522,888 to Garceran, *et al.* (hereinafter "Garceran").

Claims 35-36 and 40-41, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Andersson, in view of Bridges and further in view of the cited portions of U.S. Patent No. 6,212,377 to Dufour, *et al.* (hereinafter "Dufour").

Claim Rejections Under 35 U.S.C. § 103(a)

As to the rejection of claims 1 and 17 under 35 USC § 103(a), in addition to the reasons stated above, the office action has not established a *prima facie* case of obviousness for this additional reason: the prior art does not teach or suggest all the claim limitations. The Applicants agree with the office action that Anderson does not teach or suggest "user-defined, location-dependent rules associated with at least one telephone service subscribed to by the mobile subscriber." The office action says that Bridges teaches this at Col 6, line 52, through Col. 7, line 5. This is not correct. That entire passage from Bridges is reproduced below:

According to another embodiment of the present invention, a method is provided for selecting a preferred wireless carrier for a mobile station to enable wireless communication when the mobile station is roaming outside of a home market area. A database of preferred wireless carrier identities for a plurality of market areas based upon predetermined classes of service is compiled at a predetermined location remote from the mobile station, and a list of preferred wireless carrier identities is generated based upon a selected class of service and the plurality of market areas. The list is provided to a storage device associated with the mobile station designated with the selected class of service to enable a selection of the preferred wireless carrier. The method comprises receiving a signal transmitted by a wireless carrier containing the wireless carrier's identity, comparing the wireless carrier's identity to the database of preferred wireless carrier identities stored in the mobile station, and switching a communications mode within the mobile station so as to obtain service from the highest priority wireless carrier available.

Nowhere in this passage does Bridges teach that the mobile station (*i.e.*, the user) defines the rules. Thus, the prior art does not teach all the claim limitations and claims 1 and 17 are allowable for this additional reason.

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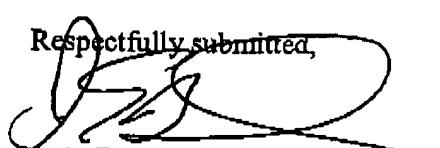
The remaining claims all depend from either claim 1 or claim 17 and are believed to be allowable for the reasons stated above. Further, each of these claims include limitations not taught by Anderson. If the Examiner maintains rejections of these claims by combining the teachings of the prior art, then the Applicants expect the Examiner to either cite a reference or provide an affidavit for the motivation or suggestion that one would combine the references to make the Applicants' invention.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


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